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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,062	12/10/1999	TAO TAO	17634-00034U	9639

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[REDACTED] EXAMINER

BROWN, STACY S

ART UNIT	PAPER NUMBER
1648	13

DATE MAILED: 04/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/459,062	TAO ET AL.	
	Examiner	Art Unit	
	Stacy S Brown	1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 February 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 31-45 and 56-58 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-30 and 46-55 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 December 1999 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' amendment received on March 12, 2002 is acknowledged and entered. The objection to the specification is withdrawn in view of Applicant's arguments. The rejection of claims 29 and 30 under 35 U.S.C. 112, second paragraph is withdrawn in view of Applicant's arguments.
2. Claims 1-58 are pending. Claims 1-30 and 46-55 are examined. Claims 31-45 are withdrawn from consideration being drawn to non-elected inventions.

Claim Rejections - 35 USC § 102

3. Claims 1-10, 12, 19-23, 25, 28-29, 46-50 and 53-55 remain rejected under 35 U.S.C. 102(e) as being anticipated by Belshe *et al.* (5,869,036) for reasons of record. Applicants' arguments have been carefully considered but not found persuasive.

Applicants mainly argue that:

- Belshe's disclosure is non-enabled. Belshe is limited to a plasmid expressing a wtPIV3 L protein with a restrictive temperature and speculates that the L gene of cp45 possesses mutations that might be useful in a vaccine. Belshe fails to show cDNA constructs that produce wtPIV3 viruses or chimerics. Belshe fails to recover any virus from cDNA.
 - In response, Belshe describes a method for producing an attenuated hybrid/chimeric virus from a cDNA clone (cols. 9-10). One of skill would have had a reasonable expectation of success that Belshe's description (cols. 9-10) would have produced a hybrid/chimeric virus.

Hoffman *et al.* (reference BM of IDS) show the construction and recovery of a full-length clone of HPIV-3 encoding a recombinant, infectious virus (pages 6-7). Therefore, at the time of Belshe's invention, methods of construction and isolation of recombinant, infectious PIV clones were known.

- Belshe's disclosure is unreliable. Belshe fails to disclose the nature of the attenuations *in vivo*. Applicants have provided evidence to show that not all attenuating mutations *in vitro* would be attenuated *in vivo*.
 - In response, it should be noted that Applicants' claims are drawn to products only, not methods of making. Belshe fails to disclose the nature of the attenuating mutations *in vivo*. Applicants are claiming *one* or more attenuating mutations and Belshe describes at least one attenuating mutation that is identical to Applicants' mutation. Therefore, the product of Belshe is expected to have the same attenuating features as Applicants' product.

Claim Rejections - 35 USC § 103

4. Claims 1-30 and 46-55 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Belshe *et al.* ('036) in view of Collins *et al.* ('957) and Klein *et al.* (WO93/14207) for reasons of record. Applicants' arguments have been carefully considered but not found persuasive for the reasons above.

Double Patenting

5. Claims 1-10, 12, 19-30, 46-50, 53 and 54 remain provisionally rejected over claims 1-6, 8-12, 15-16, 18-22, 24-26, 34-39 and 40 of co-pending application 09/458,813 for reasons of record.

Conclusion

6. No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Papers relating to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 located in Crystal Mall 1. The Fax number for Art Unit 1648 is (703) 308-4426. All Group 1600 Fax machines will be available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Stacy S. Brown, whose telephone number is (703) 308-2361. The Examiner can normally be reached on Monday through Friday and alternate Wednesdays from 6:30 AM-4:00 PM, (EST). If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, James C. Housel, can be reached at (703) 308-4027. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Stacy S. Brown
April 22, 2002


JAMES HOUSEL 4/22/02
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600